| Unite | D STATES PATENT A | nd Trademark Office | UNITED STATES DEPARTM United States Patent and T Address: COMMISSIONER OF PATE PO. Box 1450 Alexandra, Virginia 22313-145 www.uspto.gov | rademark Office NTS AND TRADEMARKS |
|---|-------------------------------|----------------------|--|---------------------------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 09/820,568 | 03/29/2001 | Dillis V. Allen | G-38 | 4968 |
| 759 DILLIS V. AL ATTORNEY A' 1080 Nerge Roa Elk Grove Villa | LEN T LAW Id, Suite 205 | | EXAMI PASSANITI, S ART UNIT 3711 DATE MAILED: 05/15/2003 | |

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Please find below and/or attached an Office communication concerning this application or proceeding.

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| | — ——————————————————————————————————— | Application No. | Applicant(s) | | |
|--|--|--|--|--|--|
| Office Action Summary | | 09/820,568 | ALLEN ET AL. | | |
| | | Examiner | Art Unit | | |
| | | Sebastiano Passaniti | 3711 | | |
| | The MAILING DATE of this communica | tion appears on the cover sheet wi | th the correspondence address | | |
| Period fo | | | | | |
| THE I - Exter after - If the - If NO - Failu - Any r | ORTENED STATUTORY PERIOD FOR MAILING DATE OF THIS COMMUNICA isions of time may be available under the provisions of 3 SIX (6) MONTHS from the mailing date of this communic period for reply specified above is less than thirty (30) d period for reply is specified above, the maximum statuto re to reply within the set or extended period for reply will, eply received by the Office later than three months after id patent term adjustment. See 37 CFR 1.704(b). | TION. 7 CFR 1.136(a). In no event, however, may a mathematication. ays, a reply within the statutory minimum of thirthy pry period will apply and will expire SIX (6) MON by statute, cause the application to become AB | eply be timely filed y (30) days will be considered timely. THS from the mailing date of this communication. ANDONED (35 U.S.C. § 133). | | |
| 1)⊠ | Responsive to communication(s) filed | on 24 February 2003. | | | |
| 2a) | , | This action is non-final. | | | |
| 3) | Since this application is in condition fo closed in accordance with the practice | r allowance except for formal mat | | | |
| - | on of Claims | | | | |
| - | Claim(s) $1-12$ is/are pending in the app | | | | |
| | 4a) Of the above claim(s) is/are v | withdrawn from consideration. | | | |
| | Claim(s) <u>1-7</u> is/are allowed. | | | | |
| | Claim(s) <u>8-12</u> is/are rejected. | | | | |
| · | Claim(s) is/are objected to. | | | | |
| | Claim(s) are subject to restriction on Papers | n and/or election requirement. | | | |
| 9)[] - | The specification is objected to by the E | xaminer. | | | |
| 10) 🗌 - | The drawing(s) filed on is/are: a) | accepted or b) objected to by t | he Examiner. | | |
| _ | Applicant may not request that any object | | | | |
| 11) 🗌 - | The proposed drawing correction filed or | | isapproved by the Examiner. | | |
| | If approved, corrected drawings are requir | •• | | | |
| 12) | The oath or declaration is objected to by | the Examiner. | | | |
| Priority u | nder 35 U.S.C. §§ 119 and 120 | | | | |
| 13) | Acknowledgment is made of a claim for | foreign priority under 35 U.S.C. | § 119(a)-(d) or (f). | | |
| a)[| ☐ All b) | | | | |
| | 1. Certified copies of the priority documents have been received. | | | | |
| | 2. Certified copies of the priority doe | cuments have been received in A | pplication No | | |
| | 3. Copies of the certified copies of t application from the Internation ee the attached detailed Office action for | onal Bureau (PCT Rule 17.2(a)). | - | | |
| 14) 🗌 A | cknowledgment is made of a claim for c | domestic priority under 35 U.S.C. | § 119(e) (to a provisional applicatio | | |
| | The translation of the foreign languation of | | | | |
| Attachment | | · | | | |
| | e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (PTO- | | Summary (PTO-413) Paper No(s) nformal Patent Application (PTO-152) | | |

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DETAILED ACTION

This Office action is responsive to communication received 02/24/2003 – paper styled, "RESPONSE TO OFFICE ACTION".

Applicant's remarks with respect to the maintenance fees, the required supplemental reissue declaration and the pending litigation are acknowledged.

Claims 1-12 remain pending.

Following is an action on the MERITS:

Claims 8-12 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc.* v. *Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp.* v. *United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application.

Specifically, as to claim 8, the applicant notes in his reissue declaration that claim 8 corresponds substantially to original patent claim 1 with the deletion of the phrase "having a top surface that is coplanar with or projects upwardly a short distance from the

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top wall" while also reciting that the ferrule is mounted "adjacent the hosel". Here, the applicant has failed to further recite that the ferrule has a downwardly depending flange seated "in a groove", as was the case in original claim 1 of the patent. The fact that the groove is an essential part of the claimed invention was vehemently argued on page 4 of the amendment received 11/23/1998 in parent application serial number 08/960,966.

Specifically, as to claim 9, the applicant notes in his reissue declaration that claim 9 corresponds substantially to original patent claim 6 with the cancellation of "on the hosel top surface" and the substitution therefor with the phrase "adjacent the hosel". Here, the applicant has failed to further recite that there exists an annular groove in the club head coaxial with the hosel bore and wherein the ferrule has an integral downwardly depending annular flange seated in the annular groove. Again, the fact that the groove is an essential part of the claimed invention was vehemently argued on page 4 of the amendment received 11/23/1998 in parent application serial number 08/960,966.

Specifically, as to claims 10, 11 and 12, the applicant notes in his reissue declaration that the phrase "substantially tangent" has been substituted for the term "tangent". Here, it is noted that the term "tangent" was specifically added by amendment to each of original claims 1, 6 and 7 and argued by the applicant in order to define over the prior art of record. See pages 1-3 of the amendment received 11/23/1998 in parent application serial number 08/960,966, wherein it is clear that the nature of the addition to the claims shows that this limitation (i.e., the addition of the term "tangent") was added in direct reply to the prior rejection.

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Claims 1-7 are allowable over the prior art references of record. Claims 8-12 appear to avoid the prior art of record.

An initialed copy of the Information Disclosure Statement (IDS) received 05/13/2002 is enclosed with this Office action. The IDS has been slightly modified to facilitate the initialing, signing and dating of the IDS papers by the examiner. However, the content of the citations found on the IDS as filed by the applicant has not been altered.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-308-7768 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Sebastiano Passaniti Primary Examiner Art Unit 3711

S.Passaniti/sp May 14, 2003